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In re Application of :
LIENERT, Klaus-Wilhelm *et al* :
U.S. Application No.: 10/511,172 :
PCT No.: PCT/EP03/03836 :
Int. Filing Date: 14 April 2003 :
Priority Date: 15 April 2002 :
Docket No.: 007376-0312476 :
For: MICROCAPSULES FOR THE :
PRODUCTION OF STORAGE-STABLE :
UNSATURATED POLYMER :
COMPOSITIONS :

DECISION

This decision is in response to the "Petition to Withdraw Holding of Abandonment Pursuant to 37 C.F.R. §1.181" filed on 02 August 2006. No fee is required.

BACKGROUND

On 09 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a \$130.00 surcharge fee must be provided. A two-month time period for response was set with extensions of time available pursuant to 37 CFR 1.136(a).

On 16 March 2005, applicants purportedly filed via facsimile a reply to the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, an executed declaration and authorization to charge the required fees to Deposit Account No. 03-3975.

On 28 April 2006, a status inquiry was filed.

On 17 July 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to respond to the Form PCT/DO/EO/905 mailed 09 March 2005 within the time period set.

On 02 August 2006, applicants filed the subject petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, copies of the documents

purportedly filed via facsimile on 16 March 2005 and a copy of an "Auto-Reply Facsimile Transmission" dated 16 March 2005.

DISCUSSION

Applicants claim that a response to the Form PCT/DO/EO/905 was filed via facsimile on 16 March 2005. This response included an executed declaration and authorization to charge the required surcharge fee. USPTO financial records show that the surcharge fee was charged on 16 March 2005. However, the declaration and other papers were not located in the file.

37 CFR 1.8 *Certificate of mailing or transmission*, states in part:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

In the subject petition, applicants request to withdraw the holding of abandonment and have provided a copy of the documents purportedly filed 16 March 2005. Applicants included an "Auto-Reply Facsimile Transmission" from the USPTO.

A review of the evidence shows that the USPTO received a facsimile on 16 March 2005. The cover page of the facsimile was titled "Certification of Facsimile Transmission Under 37 C.F.R. 1.8" and lists the proper U.S. application number, title and applicants. The document certifies that a "Response to Notification of Missing Requirements," "Fee Transmittal" and "Declarations Executed by the Inventors (8

pages)" were among the papers received. The statements in the petition are sufficient to satisfy item (3) of 37 CFR 1.8(b). Moreover, the surcharge fee of \$130.00 was charged in the subject application on 16 March 2005.

This evidence meets the requirements of 37 CFR 1.8(b) and is sufficient for a grantable petition.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment is **GRANTED**.

The Form PCT/DO/EO/909 mailed 17 July 2006 is hereby **VACATED**.

The declaration originally filed 16 March 2005 is in compliance with 37 CFR 1.497(a) and (b).

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 14 April 2003, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 16 March 2005.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



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